

REMARKS

By this amendment, claim 1 has been amended, and claims 14 and 15 have been cancelled. **The claims remaining in consideration are claims 1-13. Examination of claims 3 and 7 is dependent on the allowance of an identified generic claim upon which those claims depend. The independent claim remaining in consideration is claim 1.** No new matter has been added by this amendment.

I. Election/Restrictions

Applicant confirms that he has selected Invention I identified by the Examiner and provisional selected Species a, which includes claims 1, 2, 4-6, and 8-13. As the Examiner has acknowledged, claims 1, 4, 5, and 8-12 are generic.

II. Objections to the Drawings

The Examiner has objected to the drawings as failing to include certain reference numerals, “36” and “32”, mentioned in the description, using the reference numerals “34” and “18” to designate two different elements, and using a reference numeral, “24”, which is not mentioned in the description. Applicant has amended the description herein to correct the inconsistent references to items “18”, “34”, and “40”. A replacement drawing sheet with revised Figs. 3, 4, and 5 addressing the consistent use of these reference numerals is submitted herewith. Applicant respectfully requests reconsideration of this objection.

III. Claim Rejections under 35 U.S.C. § 102(b)

U.S. Patent No. 6,588,637 to Gates et al.

The Examiner has rejected claims 1, 2, 4-6, and 8-11 as being anticipated by U.S. Patent No. 6,588,637 to Gates et al. (the “‘637 patent”). Applicant respectfully requests reconsideration of this rejection.

The ‘637 patent discloses a “utility holding device” designed to be attached to various support structures. The ‘637 patent includes a generally U-shaped structure (10) that is

connected to a mounting stem (16). The mounting stem is threaded into a support base (12), which in turn relies on a U-bolt (48) to be attached to a support structure.

In contrast to the structural complexity of the invention of the '637 patent, Applicant's claims focus on an invention of intentional structural simplicity in which significantly fewer parts are required, rendering Applicant's invention more compact and easier to use in the field. Applicant has amended claim 1 herein to emphasize this aspect of the claimed invention. Amended claim 1 describes the clamping and firearm supporting surfaces as being integral with the elongated support member. As described above, the structure of the '637 patent utilizes multiple pieces to accomplish its attachment and supporting functions. Furthermore, the adjusting mechanism of the Applicant's invention adjusts the position of the collar relative to the clamping surface through movement parallel to the elongated support member. This facilitates one-handed placement, adjustment and use of the Applicant's invention. In contrast, the structure of the '637 patent provides for an adjustment mechanism that tightens the U-bolt (48) relative to the support base (12) in a motion perpendicular to the U-shaped structure, requiring two hands for placement and adjustment. Therefore, the '637 patent does not suggest or describe each limitation of amended claim 1.

Applicant submits that amended independent claim 1 is allowable over the '637 patent. Dependent claims 2, 4-6, and 8-1 (as well as claims 3 and 7) include the limitations of independent claim 1 and are therefore similarly allowable over the '637 patent. Applicant respectfully requests reconsideration of this rejection.

IV. Claim Rejections under 35 U.S.C. § 103

U.S. Patent No. 6,588,637 to Gates et al.

The Examiner has rejected claim 12 as being unpatentable over the '637 patent. Applicant respectfully requests reconsideration of this rejection.

As discussed above, the '637 patent does not include each limitation of amended claim 1. There is no suggestion that that these limitations would have been obvious to one of ordinary skill in the art. Therefore, Applicant respectfully submits that the '637 patent does not render the claims of the Applicant obvious. Reconsideration of this rejection is respectfully requested.

U.S. Patent No. 4,531,643 to Bradley and U.S. Patent No. 1,090,929 to McFaddin

The Examiner has rejected claims 1, 2, 4-6, 8-11, and 13 as being unpatentable over the combination of U.S. Patent No. 4,531,643 to Bradley (the “‘643 patent”) and U.S. Patent No. 1,090,929 to McFaddin (the “‘929 patent”). Applicant respectfully requests reconsideration of this rejection.

While the Examiner has provided a proposed suggestion for combination of the ‘643 and ‘929 references, Applicant respectfully asserts that the Examiner relied on hindsight reconstruction to form this objection, a practice the Supreme Court warned against in *Graham et al. v. John Deere Co.*, 148 U.S.P.Q. 479 (1966). See also *Grain Processing Corp. v. American Maize Products Co.*, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988) (“Care must be taken to avoid hindsight reconstruction by using ‘the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.’”) (internal citation omitted); *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Hindsight reconstruction is suggested in this case by the fact that the combination of the ‘643 patent with the ‘929 patent would render the invention of the ‘643 patent inoperable for its intended purpose, which results in an impermissible combination. See *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (a modification to a prior art reference which renders the reference inoperable for its intended purpose is inappropriate for an obviousness inquiry). The ‘643 patent discloses an implement holder intended to support various sporting implements when the user does not desire to hold them. See ‘643 patent, col. 1, lns.13-40. Further, the ‘643 patent seeks to provide a holder that can be supported by supports in a variety of orientations, thereby requiring that the holder be supported by a base that is adjustable relative to the holder. *Id.* at col. 2, lns. 49-57. The holder itself is clearly intended to always be used in the same upright position. It is entirely unclear how the support apparatus of the ‘929 patent, if used in place of the base disclosed in the ‘643 patent, could satisfy this stated functionality. Further, it appears that that the structure of the ‘929 patent would not be able to support the holder of the ‘643 patent properly on a horizontal support. Fig. 4 of the ‘929 patent illustrates the disclosed structure as

hanging from a horizontal support (X). The very nature of the structure of the '929 patent clearly suggests that it would not provide stable support if one would attempt to install it on a horizontal member in a position above the support. However, such a position is exactly what is necessary to properly support the holder of the '643 patent relative to a horizontally oriented support. Therefore, the use of the structure of the '929 patent actually reduces the mounting options for the holder of the '643 patent, thereby rendering the '643 holder inoperable for one of its stated purposes and resulting in an improper combination. *See In re Gordon*, 733 F.2d at 902. Therefore, Applicant respectfully submits that it is improper to combine the '643 and '929 patents in order to render claims 1, 2, 4-6, 8-11, and 13 obvious.

Additionally, Applicant notes that neither the '643 nor '929 patent discloses an elongated support member having an integral clamping surface and firearm support surface. Therefore, Applicant respectfully submits that, even if the combination of references asserted by the Examiner were proper, the '643 and '929 patents, either alone or in combination, still do not render the claims of the Applicant obvious. Reconsideration of this rejection is respectfully requested.

V. Conclusion

Accordingly, Applicant respectfully submits that the pending claims are allowable over U.S. Patent No. 6,588,637 to Gates et al.; U.S. Patent No. 4,531,643 to Bradley; and U.S. Patent No. 1,090,929 to McFaddin, either alone or in combination. Therefore, Applicant submits that all claims are allowable over the prior art made of record.

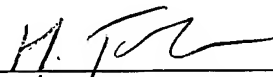
The additional references that have been cited, but not applied against the claims, are noted. It is appreciated that these additional references also do not disclose or suggest the applicant's claimed invention.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal

communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Response is respectfully requested.

Respectfully submitted,



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